

### **REMARKS**

Applicants appreciate the Examiner's thorough review of the present application, and respectfully request reconsideration in light of the preceding amendments and the following remarks.

Claims 1-5, 8-10 and 20-26 are pending in the instant application. Independent claims 1 and 8 have been amended to better define the claimed invention. The amended claims find solid support in at least FIG. 5 of the application as filed. No new matter has been introduced through the foregoing amendments.

1. The finality of the current Office Action is premature and should be withdrawn.

In particular, the Examiner's new ground of rejections raised against claims 1 and 8 were not necessitated by Applicant's amendments.<sup>1</sup>

In this particular case, claim 1 was amended only to include the subject matter of claim 7, which was previously indicated to be allowable, and claim 8, which was previously indicated to be also allowable, was only rewritten in independent form without otherwise touching the merits. The Examiner's decision to withdraw the previously indicated allowable subject matter and to raise new grounds of rejection against claims 1 and 8 was apparently the initiative of the Office, and was in no way necessitated by Applicant's taking the subject matter previously indicated to be allowable.

Withdrawal of the finality of the current Office Action in view of the above is believed appropriate and therefore respectfully requested.

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<sup>1</sup> Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). *See MPEP*, section 706.07(a) (emphasis added).

2. The 35 U.S.C. 103(a) rejection of **claim 8**<sup>2</sup> as being obvious over *Parish* in view of *Vogt* is traversed, because a *prima facie* case of obviousness has not been established.

In particular, the Examiner has not presented any evidence that would have led a person of ordinary skill in the art to modify the prior art device to arrive at the claimed invention. Instead, the Examiner merely stated that the claimed invention would have been obvious because Applicants did not disclose that the claim feature provides any advantage or solves a stated problem.

Applicants first note that the Examiner's statement does not amount to a clear articulation of the reason(s) why a person of ordinary skill in the art would have modified the references to arrive at the claimed invention.<sup>3</sup>

Furthermore, Applicants note that the Examiner's obviousness rationale is flawed as has been held repeatedly by the Board of Patent Appeals and Interferences, i.e., the mere (arguable) fact that a difference (between the teachings of the prior art and the claimed subject matter) does not solve any recognized problem does not, *ipso facto*, make that difference obvious under 35 U.S.C. 103. The Examiner is kindly asked to consult the Supervisory Primary Examiner to confirm Applicants' position on this point. Copies of several decisions by the Board are also enclosed herewith for the Examiner's information.<sup>4</sup> If the Examiner sustains the initial position that the claim feature is obvious merely because it does not serve any stated purpose or solve any particular problem, the Examiner is kindly asked to provide legal authority for such holding.

Withdrawal of the rejection of claim 8 in view of the above is believed appropriate and therefore respectfully requested.

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<sup>2</sup> See Office Action at page 4.

<sup>3</sup> See *MPEP*, section 2141: "[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1396.

<sup>4</sup> See, e.g., the framed text at pages 9-10 of *Exhibit A*, page 11 of *Exhibit B*, and page 8 of *Exhibit C*.

3. The 35 U.S.C. 103(a) rejection of all pending claims as being obvious over *Parish* in view of *Vogt* is believed overcome in view of the above amendments.

*Parish* relates to a liquid diverter for a currency receiver. *Parish* discloses a liquid diverter 20 positioned adjacent to a slot 58, wherein the liquid diverter 20 has a top member 80 and a bottom member 82, the bottom member 82 including apertures 100, 102, and 104, wherein a curvilinear surface matches the curves of ribs 108 provided in the bottom member 82 interposed between the apertures 100, 102, and 104 (Fig. 2 and 3). However, *Parish* fails to disclose the mounting member of the claimed invention which was a first open end and a second open end.

*Vogt* relates to a protective device 10 for use in a vending machine 100 to protect lower electric equipment of a bill validator 120, such as a coin changer 130 selection switches, display, harnessing and the like. The protective device 10 includes a catch pan 12, attached to the vending machine 100 below the bill validator 120 (Abstract and Fig. 1). The Examiner stated in the present Office Action that the first open end and the second open end of the claimed invention are disclosed as a bottom portion 14 and a conduit 34 of the catch pan 12.

The Examiner further stated in the present Office Action that it would have been obvious to one of ordinary skill in the art to modify the liquid diverter 20 of *Parish*, with the catch pan 12 of *Vogt* to arrive at the claimed invention. However, *Vogt* fails to disclose a mounting member (catch pan) located directly below the bill guide plate. *Vogt*'s device is aimed at shielding the lower electrical equipment by providing the catch pan 12 between the bill validator and the lower electrical equipment (Col. 3, L. 13-21). The catch pan 12 can not protect the bill validator 120 (Fig. 1) because it is not provided directly below bill guide plate 124/126. In contrast according to the claimed invention, by providing the mounting member directly below the bill guide plate, all equipment, including any bill validator and the lower electrical equipment are safely protected.

Thus, the Examiner's combination of *Parish* and *Vogt*, if proper, would still fail to teach or disclose all features of the independent claims.

The dependent claims are considered patentable at least for the reasons advanced with respect to the respective independent claims.


Each of the Examiner's rejections has been traversed/overcome. Accordingly, Applicants respectfully submit that all claims are now in condition for allowance. Early and favorable indication of allowance is courteously solicited.

The Examiner is invited to telephone the undersigned, Applicant's attorney of record, to facilitate advancement of the present application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 07-1337 and please credit any excess fees to such deposit account.

Respectfully submitted,

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